

## REMARKS

Claim 1 herein has been rejected under an obviousness-type double patenting rejection over Claim 1 of Bristow et al. (U.S. Patent No. 6,754,868). In this regard, a Terminal Disclaimer with respect to Bristow et al. is enclosed herewith and is assumed to overcome this rejection.

Claims 1, 4-7, 10-17 and 20-23 have been rejected under 35 U.S.C. §102(e) as being anticipated by Bristow et al. Claims 2-3, 8-9 and 18-19 have been rejected under 35. U.S.C. §103(a) as being unpatentable over Bristow et al. in view of Fujisaki (U.S. Patent No. 5,852,618).

35 U.S.C. §103(c) provides that subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of 35 U.S.C. §102, shall not preclude patentability under such section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. Nextest Systems Corporation owns the referenced application, as evidenced by an assignment recorded on March 12, 2002 at Reel 12688, Frame 962 at the U.S. Patent and Trademark Office, and likewise owns Bristow et al., as evidenced by an assignment recorded on September 24, 2001 at Reel 12200, Frame 182 at the U.S. Patent and Trademark Office. In view of the foregoing, the rejection of Claims 1, 4-7, 10-17 and 20-23 under 35 U.S.C. §102(e) as being anticipated by Bristow et al. should be withdrawn.

With respect to the rejection of Claims 2-3, 8-9 and 18-19 under 35. U.S.C. §103(a), Claims 2-3 depend from Claim 1 and are patentable for the same reasons as Claim 1 and by reason of the additional limitations called for therein, Claims 8-9 depend from Claim 7 and are patentable for the same reasons as Claim 7 and by reason of the additional limitations called for therein, and Claims 18-19 depend from Claim 17 and are patentable for the same reasons as Claim 17 and by reasons of the additional limitations called for therein.

In view of the foregoing, it is respectfully submitted that the claims of record are allowable and that the application should be passed to issue. Should the Examiner believe that the application is not in a condition for allowance and that a telephone interview would help further prosecution of this case, the Examiner is requested to contact the undersigned attorney at the phone number below.

Respectfully submitted,

DORSEY & WHITNEY LLP

By

  
Edward N. Bachand, Reg. No. 37,085

Four Embarcadero Center, Suite 3400  
San Francisco, CA 94111-4187  
Telephone No. 650-494-8700  
Facsimile No. 650-494-8771  
1080705